

No. 2314.

IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

OCTOBER TERM, 1913.

PACIFIC PHONOGRAPH COMPANY,
Appellant,

vs.

SEARCHLIGHT HORN CO.,
Appellee.

BRIEF FOR APPELLEE.

JOHN H. MILLER,
WM. K. WHITE,
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THE JAMES H. BARRY CO.

FILED

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	<i>Appellant,</i>
	<i>Appellee.</i>

BRIEF OF APPELLEE.

This is a companion case to those of Sherman Clay & Company vs. Searchlight Horn Company, No. 2306 and No. 2307, in this court.

The three cases involve the same patent, the main difference between them being as to the defendant. The defendant in the former cases was Sherman Clay & Company, the Pacific Coast distributors of the Victor horns, while the defendant in the case at bar is Pacific Phonograph Company, the distributor of the Edison horns. The two horns (Victor and Edison) are substantially the same in appearance, form, struc-

ture and mode of operation. If one is an infringement, necessarily the other is likewise.

This appeal is taken from an order granting a preliminary injunction for infringement of patent No. 771,441, to Peter C. Nielsen, for phonograph horns, dated October 4, 1904. The bill was filed May 9, 1913, and sets up as the basis for the preliminary injunction prior adjudication of the patent on final hearing in an action at law by the appellee herein against Sherman Clay & Company had on October 4, 1912. The facts are that after said former adjudication in the suit, No. 2306, against Sherman Clay & Company, a motion for a new trial therein was denied by the court after elaborate arguments, and thereupon the Searchlight Horn Company began a suit in equity, No. 2307, and moved for and obtained a preliminary injunction against Sherman Clay & Co. Appellee then began the present suit in equity against the Pacific Phonograph Company for the purpose of reaching the Edison horns, which were substantially the same as the Victor horns, and on May 9, 1913, served notice of motion for preliminary injunction. The notice stated that at the hearing plaintiff would rely on the bill of complaint, affidavits of William H. Locke, Jr., and John H. Miller, together with a copy of the patent in suit and a catalogue of the Edison phonographs, also the judgment-roll, petition for new trial, order denying the new trial, and the horn exhibits in connection with the action against Sherman

Clay & Company, No. 15,326, and also the papers and pleadings in the equity suit against Sherman Clay & Company, and the order granting a preliminary injunction therein. By stipulation the records in the Sherman & Clay cases are made a part of the record herein (Rec. 220).

The affidavit of Locke showed that he had been connected with the phonograph business since January, 1904, and was thoroughly familiar with the same and the state of the art, that up to the year 1907 horns were not a part of the equipment of the Phonograph Companies, but were manufactured by independent parties and supplied by them to jobbers, who in turn sold them with the phonographs which had been furnished by the phonograph companies; that prior thereto the Searchlight Horn Company had been making and selling the Nielsen horn to jobbers and had invested a large sum of money in the business; that in 1907, the Phonograph Companies made the horns a part of their equipment and supplied the same to the jobbers, so that the horns became a monopoly with the Phonograph Companies, as well as the phonographs themselves, and the Searchlight Horn Co. could no longer continue its business of the manufacture and sale of horns at a profit, for the reason that their former customers were compelled to buy the horns together with the phonographs from the Phonograph Companies, and thus the Searchlight Horn Co. was forced to discontinue the manufacture of its horns

in May, 1908; that thereafter and during a long period of time the Searchlight Horn Co. endeavored to make arrangements with the phonograph companies for the payment of royalties for the use of the patented horn, having already notified them that they were infringements, and also endeavored to sell the patent to the phonograph companies, among whom was the National Phonograph Co., who furnished the horns to defendant herein; these negotiations were carried on until September, 1909, when the National Phonograph Co. in writing notified the Searchlight Company that no arrangements would be made, and thereafter the National Phonograph Co. continued the infringement in defiance of plaintiff; that thereafter the Searchlight Co. endeavored to secure the services of a patent lawyer to prosecute infringers, but by reason of the fact that the company was largely in debt and financially distressed, was not able to secure an attorney until April, 1910, when the present attorney was secured; thereafter the present attorney made a thorough investigation of the matter and in 1911 commenced as a test case an action against Sherman Clay & Company, which in May, 1912, resulted in a verdict in favor of the patent owner. After the entry of that judgment Locke had personal conferences with representatives of the National Phonograph Co. (the name has been changed to Thomas A. Edison, Inc.), for settlement of their infringement so that litigation might be avoided; these negotiations

proved abortive, and thereupon in March, 1913, suit was brought against Babson Brothers and shortly afterwards against Pacific Phonograph Company, two distributors of the Edison horns on the Pacific Coast. The affidavit then contains the usual allegations of continued infringement, irreparable injury, no fixed royalty, etc.

The affidavit of John H. Miller shows that he was employed in 1910 and immediately made extensive investigation into the matter, and as soon as the same was completed began an action at law against Sherman Clay & Company as a test case; that after commencing the suit he notified Thomas A. Edison, Inc., of the same and thereupon entered into negotiations looking toward a settlement, which negotiations were carried on for a considerable time, but resulted in nothing. The affidavit also shows that he notified the attorneys for Thomas A. Edison, Inc., of the defenses that had been set up in the Sherman Clay & Company case, also the result of that case, and sent them a copy of the court's charge to the jury so that they might be fully advised of what occurred therein, hoping that after the patent had been adjudicated in the test case there would be no further contest, and that Thomas A. Edison, Inc., would make settlement; that these efforts at settlement proving abortive, the present suit was begun. The affidavit also shows that the Pacific Phonograph Co. was infringing upon the patent by selling horns obtained from Thomas A.

Edison, Inc., which were substantially of the same construction as the Victor horns which had been involved in the Sherman Clay & Co. case. A catalogue was introduced and filed in connection with the affidavit showing cuts of the infringing horns, from which it appears that they were substantially the same as the Victor horns. The affidavit also stated that the reason why said suit was not sooner begun against the dealers in Edison horns was that affiant did not consider it advisable to multiply suits against different infringers while the test case against Sherman Clay & Company was pending, hoping that after the adjudication of the patent in said test case no further litigation would be necessary, in all of which he was disappointed, and notwithstanding the adjudication of the Sherman Clay & Co. case, the defendant herein continued to infringe.

The defendant in the Sherman-Clay case petitioned for a new trial and the action of the court thereon denying the same appears at page 37 of the record. The testimony and exhibits in said Sherman Clay & Co. case have not been brought to this court by the appellant, although they were used upon the hearing of the motion for an injunction. However, they are before this court in the case of Sherman Clay & Company, plaintiff in error, against Searchlight Horn Co., defendant in error, No. 2306, and by stipulation (Rec. 220) are made a part of the record herein. We shall

refer to that record as a part of the record in the case at bar.

In answer to the order to show cause, the appellant herein filed an answer setting up the usual defenses of want of invention, anticipation by prior patents and publications, prior use, and non-infringement. Accompanying this were affidavits by a large number of persons and a mass of prior patents, the latter constituting Vol. 2 of the Record.

Mr. Louis Hicks, a patent lawyer of New York City, came to San Francisco and personally argued the motion on behalf of appellant, and after a most exhaustive and thorough presentation thereof the learned judge of the lower court (Hon. William C. Van Fleet) granted the injunction. Judge Van Fleet was the same judge who had presided at the trial of the action at law against Sherman Clay & Company, who had heard and denied the motion for a new trial therein, and had granted the preliminary injunction against Sherman Clay & Company. Consequently, he was fully posted and well qualified to pass on the motion for an injunction in the case at bar.

On the granting of the motion appellant petitioned for the allowance of an appeal and filed the usual assignments of error and secured from the court an order that said appeal be allowed, and that pending the appeal the injunction be stayed upon the filing by the defendant of a bond in the sum of \$1,000.00. The bond was filed immediately, and, consequently, the

appellant has never actually been under an injunction, but is now daily infringing upon the patent by reason of having given the supersedeas bond.

ARGUMENT.

This being an appeal from an order granting a preliminary injunction, the review by this court is limited to an inquiry whether the lower court abused its discretion in granting the injunction.

On the hearing the judge of the lower court was not necessarily required to finally pass upon the large mass of evidence brought forward for the purpose of showing invalidity of the patent, and would have been entirely justified in postponing consideration thereof until the final hearing, although he did consider the same. On application for preliminary injunction it is not incumbent on a court to indulge in a final hearing of the case. Such injunctions are intended only to preserve matters in *statu quo* until a final hearing can be had on the merits. This court has repeatedly had occasion to instruct counsel on this proposition, and without dwelling on the subject, we quote from the decision of this court in the case of *Kings County Raisin & Fruit Co. vs. United States Consolidated Seeded Raisin Company*, 182 Fed., 60, as follows:

“The granting or refusing of a preliminary injunction in such a suit ordinarily rests in the sound discretion of the trial court, and the review thereof by an appellate court is limited to the inquiry

whether there was abuse of discretion in granting the writ. This rule has been so often applied by this court, and is so well established by precedent as to require the citation of no authorities. It is sufficient to refer to the language of Judge Jackson in *Blount vs. Societe Anonyme du Filtre Chamberlain Systeme Pasteur et al.*, 53 Fed., 98, 3 C. C. A., 455:

“The object and purpose of a preliminary injunction is to preserve the existing state of things until the rights of the parties can be fairly and fully investigated and determined upon strictly legal proofs and according to the course and principles of equity. The prerequisites to the allowance and issuance of such injunction are that the party applying for the same must generally present a clear title, or one free from reasonable doubt, and set forth acts done or threatened by the defendant which will seriously or irreparably injure his rights under such title unless restrained.’

“See, also, the decision of this court in *Jensen Can-Filling Machine Co. vs. Norton*, 64 Fed., 662, 12 C. C. A., 608, and *Southern Pacific Co. vs. Earl*, 82 Fed., 690, 27 C. C. A., 185.”

And in this connection we ask the court to read our brief in case No. 2307.

In view of the foregoing rule of law, the question presented to this court is, did the learned trial judge abuse his discretion in granting the motion for a preliminary injunction? A *rèsumè* of the facts would seem to be all that is necessary for an answer to this question.

The test case against Sherman Clay & Co. had been fully tried out on the merits, with the result

of a verdict sustaining the validity of the patent. A motion for a new trial had been made and denied, on which motion the court thoroughly and exhaustively considered the matter and came to the conclusion that the verdict of the jury was correct. The motion for an injunction was then made against Sherman Clay & Company, and upon the hearing of that motion the same old defenses that had been pressed in the test case were again urged and the court again considered the same and reiterated the views theretofore expressed and granted the preliminary injunction. It will thus be seen that the learned judge of the lower court had three separate exhaustive hearings of the controversy against Sherman Clay & Co. before considering the present case.

Thomas A. Edison, Inc., which company furnished to the defendant herein the infringing horns which are sought to be reached by this suit, was kept fully informed of all these proceedings. Negotiations were had with them regarding a settlement, and terms were offered which were rejected. The defenses which had been made in the test case were disclosed to them. In fact, we went so far as to forward to them a copy of the court's charge to the jury in the test case so that they could see the extent of the adjudication, and further efforts were then made to settle with them. In spite of all these proceedings thus had and taken, they continued to infringe the patent by selling throughout the Pacific Coast, through the defendant

herein and Babson Bros, as their agents, infringing horns known as the Edison flower horns, which were substantially the same as the Victor flower horns, which had been held to be an infringement. These facts alone would have justified the lower court in granting a preliminary injunction. In fact it would have been an abuse of discretion to have denied an injunction against the Edison Company distributors while an injunction was outstanding against the Victor horns distributors. No court has one rule of law for one defendant, and a different rule of law for another defendant. So long as the test case against Sherman Clay & Company stood unreversed it was the rule of law in the District Court for the Northern District of California, and it seems to us the acme of unreason for this defendant to have asked the lower court to stultify itself by refusing an injunction against the appellant for selling the same form of machine which had already been adjudged to infringe in the Sherman & Clay case, and which had therein been enjoined.

Furthermore, the apepllant herein has never for one moment been actually under an injunction. No injunction has ever actually been issued. The bond filed stayed the issuance of the injunction, so that no damage whatever has been caused to the business of the appellant. To-day the appellant is selling its infringing horns throughout the Pacific Coast without restriction. And still further, it may be noted that

this case will come up for trial at the next term of the District Court, which is the first Monday in November (Nov. 3), the same day on which this appeal is set for argument. The depositions on behalf of appellant have already been taken in the East, and the case will be tried at the earliest possible date on the calling of the District Court calendar. Consequently, the final hearing of this case will be had in the lower court probably before this court will have had time to pass upon this appeal.

The foregoing views are in our opinion sufficient to justify this court in affirming the order without further inquiry into the merits of the showing made by appellant. However, we are not opposed to considering the matter on the merits for the reason that such a consideration will conclusively show that the patent is valid and that the defendant has infringed. In fact, the showing made by appellant, so far from weakening, has strengthened the correctness of the prior adjudication.

QUESTION OF NO INVENTION AND ANTICIPATION.

These two matters may be considered together. In support of them appellant submitted a large number of prior patents. Those patents consisted of the same patents which had been submitted and passed on in the test case against Sherman Clay & Company, supplemented, however, by a few additional patents and

affidavits which were not in evidence in said test case. Insofar as concerns the patents which were in the test case, we need say nothing more than that they had already been passed on and fully exploited in the said test case, and it was no abuse of discretion for the trial judge to follow the ruling in that case. Consequently, all of the prior patents in this case which were in the test case may be dismissed from further consideration.

This leaves for consideration only the new patents introduced for the first time in the case. The rule of law on this subject is thus stated by Judge Hawley, in *Norton vs. Eagle Automatic Can Co.*, 57 Fed., 929:

"I understand the rule to be well settled that where the validity of a patent has been sustained, as in this case, by prior adjudication in the same circuit, the only question open before this court on motion for a preliminary injunction, in a subsequent suit against other parties, is the question of infringement, and that the consideration of all other questions should be postponed until all of the testimony is taken in the case and the case is presented upon final hearing. There is, perhaps, an exception to this rule—that in cases where new evidence is presented that is itself of such a conclusive character that, if it had been presented in the former case, it would probably have led to a different conclusion. The burden, however, of showing this, is upon the respondent."

This ruling has been approved and made the fixed law of the circuit by this court in *Kings County Co.*

vs. *U. S. Consolidated* (182 Fed., 61), and *Southern Pacific Co. vs. Earl* (82 Fed., 692).

It is only by virtue of the saving clause in the above quotation from Judge Hawley's opinion that the appellant has any ground whatever to stand on. It is only such "new evidence" as has been produced that can be considered at all, on this motion, and even then such new evidence must be "of such a conclusive character" that it would probably have led to a different result if it had been produced in the test case. This imposes upon the appellant an onerous burden. He must show that this new evidence is conclusive. It is not sufficient for him to show that it is persuasive.

In this connection we cite *Warren Bros. vs. City of Montgomery* (172 Fed., 421), where it is said:

"When there has been an adjudication upholding the validity of the patent, the defendant in another case, who seeks to overthrow it because of new evidence not introduced in the former case, which would have led to a different result, must make good his contention. When the defense is anticipation, it must be shown; and if there be any reasonable doubt on that point, it must be resolved against the defendant on a motion for a preliminary injunction. *Cantrell vs. Wallick*, 117 U. S., 689; *Brush vs. Condit*, 132 U. S., 39; *Coffin vs. Ogden*, 18 Wall., 120."

The same rule obtains in the Northern District of California. In the case of *Earl vs. Southern Pacific Company*, 75 Fed., 612, Judge Morrow used and

adopted the following language taken from the opinion of Judge Seaman in the case of *Edison Electric Light Co. vs. Electric Mfg. Co.*, viz.:

“One exception to this rule is sometimes allowed, and that is where there is a clear showing of a meritorious defense which was not before the court in the original suit, and which, had it entered into consideration, would probably have defeated the patent or claim. The question here is whether there is such clear showing of merit for this claim now asserted that the defendants should be relieved from the general rule by denying in their case the usual injunctional order, and the primary inquiry is, what must be the measure of proof demanded? Must it be of the quality and quantity required to defeat the patent at final hearing—clear, convincing and beyond reasonable doubt, as held by Judge Colt—or will it suffice for a denial of the motion, that it shows a defense which puts the case in doubt, as held by Judge Hallett? It is clear that the presumptions must be in favor of the patent, and that it cannot be overthrown by a mere doubt. I think the true test for proof upon the motion is that it shall be sufficient to raise a presumption that it would have defeated the patent, had it been produced at the trial. This would demand at least the full measure required to overcome the presumptive force of the patent, and that every reasonable doubt be resolved against the defense here, as it would be there, as held by Judge Colt. In the eyes of the law, at this stage, the complainants stand upon their rights, with their letters patent confirmed after arduous contests, and entitled to preliminary injunctions against infringers; and the defendants must place themselves entirely within the exception to the rule, if they invoke the privileges of that ex-

ception, and would deprive the complainants of the fruits of their hard-earned victories."

This Earl case was afterwards affirmed by the court in 82 Fed., 692.

Now let us consider the so-called new evidence which was presented in this case. It consisted of certain affidavits from Eastern infringers and certain U. S., British, and French patents and certain publications tabulated as follows:

U. S. PATENTS.

Penfield,	362,107,	May 3, 1887.
Gersdorf,	453,798,	June 9, 1891.
Gersdorf,	491,421,	February 7, 1893.
Berliner,	534,543,	February 19, 1895.
Hogan,	632,015,	August 29, 1899.
Myers,	647,147,	April 10, 1900.
Runge,	692,363,	February 4, 1902.
Martin,	738,342,	September 8, 1903.
Melville,	748,960,	January 5, 1904.
Sturges,	763,808,	June 28, 1904.
Schoettel,	769,410,	September 6, 1904.
Ruggiero,	770,024,	September 13, 1904.

BRITISH PATENTS.

Hogan,	22,612,	November 11, 1899.
Runge,	9,727,	October 4, 1901.
Runge,	22,273,	July 24, 1902.
Villy,	20,146,	June 9, 1903.
Cockman,	5,186,	November 17, 1903.
Tourtel,	14,730,	March 24, 1904.

FRENCH PATENTS.

Guerrero,	301,583,	June 23, 1900.
Turpin,	318,742,	February, 1902.
Runge,	321,507,	May 28, 1902.
Hollingsworth,	331,556,	April 28, 1903.

PRIOR PUBLICATIONS.

Hawthorne & Sheble's Glass horn circular.

Hawthorne & Sheble's general circular.

Kaiser Trademark of July 5, 1898.

Schoettel's Circular of Mega Horn.

Scott's Phonautograph of 1857.

Tewkesbury's Manual of the Edison Phonograph.

In regard to the above list of United States patents, it may be noted that those of Sturges (No. 763,808, of June 28, 1904), Schoettel (No. 769,410, of September 6, 1904), and Ruggiero (No. 770,024, of September 13, 1904), are too late in time to be of any avail. They are not prior patents, but subsequent patents, in view of the fact that Nielsen's patent was applied for on April 14, 1904. Consequently, those three named patents may be dismissed from consideration.

It may also be noted that the two patents to Gersdorf are practically only one patent, the best of which for appellant's purpose is No. 491,421. This leaves eight United States patents for consideration, and they may be disposed of in a very few words.

PENFIELD (No. 362,107) is a patent for a metallic

barrel. In other words, it is an ordinary barrel for holding liquids (such as whiskey, wine, or vinegar), made of metal staves instead of wooden staves (see Record, Vol. 2, page 243). How it can bear any relevancy to the issues herein, or can affect the validity of Nielsen's patent, passes our comprehension.

GERSDORF PATENTS (No. 491,421, of February 7, 1893; No. 453,798, of June 9, 1891) show a small metal funnel used for the purpose of filling barrels, jugs, bottles or other receptacles with liquid. It is stated in the specification (Record, Vol. 2, page 259) that it is made in two or more, preferably three, sections, joined together by lengthwise seams by bending the edges of the pieces to form flanges and then interlocking and soldering the flanges together. An ordinary funnel is made of one piece of metal folded together over a form and having the two longitudinal edges joined together by solder or otherwise. The improvement which Gersdorf proposes is to make the funnel of three pieces instead of one piece. That is all there is to Mr. Gersdorf's invention. The only relevancy it has to any issue in this case is to show that at the time of Nielsen's invention it was old in the sheet metal art to join pieces of metal together by flange seams, and then interlock and solder the flanges together. But there was no patent necessary to show that fact, for we freely admitted that Nielsen made no invention in the form of his seam alone. On the

contrary, it was a part of our case to show that the flanged form and the lock form were both old in the art, and all the witnesses in the case admitted it. Hence, this Gersdorf patent serves to strengthen our position rather than to weaken it. Probably this Gersdorf funnel was intended to be used in connection with the Penfield metal barrel for filling purposes. The argument is that inasmuch as it was old to make whiskey barrels out of metal strips and to fill said barrels by means of a funnel made in three pieces joined together by a flanged joint, therefore, it required no invention on the part of Nielsen to devise a horn for phonographs of the character described in his patent, whereby the transmission of delicate sounds and high class operatic music is accomplished without contaminating said music with the metallic vibrations of the horn. It seems to us asking too much of human credulity to suggest that the filling of a metal barrel with whiskey by means of a three-piece funnel is analogous to the transmission of sound through a phonograph horn, and would naturally and spontaneously, and without the exercise of the inventive faculty, suggest to a person in the phonograph art such a horn as is disclosed in the Nielsen patent.

BERLINER (No. 534,543, of February 19, 1895). The only relevancy which this patent is supposed to have consists in the picture of a phonograph horn somewhat similar in shape to the shape of the Nielsen

horn, and which appears in Vol. 2 of the Record at page 263. In the first place, it might be said that the only similarity that can be conjured up by the most technical mind is the shape of the horn. But it is to be remembered that Nielsen's invention does not reside solely in the shape of his horn. The shape was old in the art, as was shown in the Sherman Clay & Co. case. The shape of the Nielsen horn is material only as being one of the elements of his combination, and the citation of a prior horn having the same shape, but not the other elements of his combination, is of no avail. All the various elements of Nielsen's combination were individually old. His invention consisted in combining them together in one structure and making a new combination. But there is another reason why this Berliner patent is of no avail, and that is that the horn illustrated by the picture is not described in his specification so as to enable one to determine how it is constructed. The only description of it appearing in the patent begins at line 6 on page 5 of the specification, found on page 269 of the record. There this horn is described simply as "a sound conveying trumpet 95, the flaring end 96 of which is turned towards the listener." That is the sole description we find in the specification relating to this horn. It is simply a trumpet with a flaring end. How it is constructed, the specification does not state. Apparently it is constructed like an ordinary horn of spun brass, but that is a mere supposition. It is set-

tled law that a mere drawing or picture of an alleged prior device without verbal description does not operate as an anticipation. It is not a sufficient disclosure within the meaning of the patent law. Consequently, the Berliner patent may be dismissed from consideration.

HOGAN (No. 632,015, of August 29, 1899). This patent shows a phonograph horn of conical shape, similar to an ordinary megaphone, made of a single piece of paper folded over a form. The only relevancy it appears to have resides in the fact that the two longitudinal edges when brought together are protected by a separate metal strip. In that behalf the specification says (Record, Vol. 2, page 275):

"The trumpet is made of a sheet of tough paper or thin indurated fiber, and each of the two edges of this material that come together when the sheet is folded to the cone form are first bordered by a thin sheet-metal strip folded longitudinally, as shown at h in Fig. 5. This metal strip incloses the sheet edge like a clip and extends from the large end to the point end. The two metal strips are abutted together and joined by solder."

This patent is of no avail because the horn is made of paper, of a single piece, and in conical form, whereas Nielsen's horn is made of metal, of a multiplicity of pieces, and of flaring or bell-shaped form.

MYERS (No. 647,147, of April 10, 1900). This horn is a collapsible horn made of separate sections of

cardboard laid edge to edge and glued or gummed together by a textile fabric (see Record, Vol. 2, page 280). The fundamental idea of the patent consists of a collapsible cardboard horn, and in that respect it resembles the prior patent of Villy, which was passed upon in the test case against Sherman Clay & Company. Indeed, Villy is a better reference than Myers, and inasmuch as the former has been held to be of no value, the same ruling must be had regarding the latter.

RUNGE (No. 692,363, of February 4, 1902). This is a conical-shaped horn, called in the patent a *trumpet*, made of "tough paper, thin fiber, or celluloid." A separate bell is attached to the end of the trumpet, thus making it resemble the old B. & G. horns in shape. It is evident that this patent cannot invalidate the Nielsen patent.

MARTEN (No. 738,342, of September 8, 1903), is the patent for the old B. & G. horn. We have already considered that horn. It is astonishing to be now told that it anticipates Nielsen.

MELVILLE (No. 748,960, of January 5, 1904), represents a collapsible megaphone of conical shape when extended, made of two sections to telescope into each other. Each individual section is made of two halves united at their edges by "pliable bindings whereby the parts a a" are permitted to fold laterally into a flat

condition." The most casual examination will show that this patent cannot affect the validity of Nielsen's patent.

CONSIDERATION OF BRITISH PATENTS.

HOGAN (No. 22,612, of 1899), RUNGE (No. 9727, of 1901), and RUNGE (No. 22,612, of 1899), are the same as the corresponding United States patents of those inventors already considered, and hence it will not be necessary for us to consider the British patents in detail. Whatever has been said of the United States patents applies equally to them.

VILLY (No. 20,146, of 1903). This patent shows the same thing as the United States patent to Villy, which was fully disposed of in the Sherman Clay & Co. case and need not be considered here. It is a collapsible paper horn made of paper strips glued together on a linen background, and has no ribs of any kind.

COCKMAN (No. 5186, of 1903), shows a trumpet form of horn made of wooden strips cut "on the quarter." It is stated in the specification that theretofore such phonograph horns had been usually made of sheet metal which produced an objectionable metallic sound to the detriment of the qualities and characteristics of the music passing through the phonograph. It also says that sometimes horns had been made of *papier maché*, but they likewise were ob-

jectionable. In order to obviate this difficulty Cockman proposes to make his trumpet of wood "cut on the quarter," that is to say, "so cut that each sheet or strip radiates from the center of the tree or block." These strips are said to be "glued together at their edges" and have an outward rounded form presenting the shape of a cone. They are not curved or tapered in plan so as to produce the shape of a Nielsen horn. Neither are there any ribs found in the device. The first claim of the patent reads as follows:

"1. A trumpet built up of strips of wood cut 'on the quarter' so as to obtain a straight grain, for the purpose specified."

Clearly there is nothing here worth considering. Nielsen's horn must be of metal, must taper in plan, must have outside ribs. Cockman has none of these.

TOURTEL (No. 14,730, of 1904), shows the old style B. & G. horns, made of a conical piece A and a flaring bell B attached thereto by a circular seam (see Record, page 368). It is called a trumpet, and is stated to be made of "celluloid or other suitable resonant material." While this particular patent was not in evidence in the Sherman Clay & Co. test case, nevertheless, another patent to the same inventor Tourtel was in evidence, which shows substantially the same construction. Hence this patent of Tourtel is not new matter.

FRENCH PATENTS.

GUERRERO (No. 301,583, of 1900). This patent appears between pages 369 and 374 of the record. It is said to be constructed "of sheets or strips of wood, "very thin (about 1 millimeter), cut in suitable form, "laterally disposed and placed along the horn, from "the part the most narrow, or the beginning of the "elbow NF (Fig. 1), towards the largest part, either "the mouth or bell N of the horn." These thin strips of wood are shown as disposed in a variety of ways. In each instance they are glued together along their edges. There are no ribs of any kind. It is a wooden horn built up of thin wooden sheets without ribs.

RUNGE (No. 321,507, of 1902). This patent is the same as the British patent and the United States patent to the same inventor heretofore considered and needs no further comment.

HOLLINGSWORTH (No. 331,556, of 1903). This patent is between pages 402 and 407 of the record. It is said that the horn may be made of any material, but preferably of celluloid. It is made of two pieces of material bent together around a form so as to produce in cross-section a pear shape. By reference to page 404 of the record it will be seen that the horn largely resembles the old B. & G. horn, the only variation being that the cross-section of the trumpet part is pear-shaped instead of circular, and an outer

bell is attached to the trumpet by a circular joint of some kind. Clearly if the old B. & G. horn is of no effect, then neither is this of Hollingsworth.

TURPIN (No. 318,742, of 1902). This patent is found between pages 375 and 392 of the record and appears to be the one most relied upon by appellant. In the specification (page 383), it is stated that therefore horns had been made of pasteboard, celluloid, glass, and metal, but that none of the first three named had been successful in practice, and that metal horns were the only ones that had been employed with any degree of success. It is stated, however, that the metal horns gave out,

“metallic nasal sounds which take away all interest which the phonograph might have in itself, for it is impossible to recognize the recorded sounds, because the sounds are unnatural. It is thus that the violin cannot be suitably reproduced by a phonograph; that the high notes of a good light singer are unnatural and accompanied by a metallic hissing which disturbs the ensemble, that orchestral pieces are confused, etc. All these disadvantages which absolutely harm the phonograph and which have prevented the phonograph, which is remarkable from more than one point of view, from acquiring the serious and scientific character are due to the metallic nature of the horns which transform into a metallic sound a sound the most pure, first in the recording and then in the reproduction, whence finally into a sound of mockery for all tones and for all sounds. As a consequence of this state of things, the phonograph remains a

simple and often disagreeable toy, instead of being an apparatus faithfully reproducing sounds such as it may have received, that is to say, a perfect instrument permitting easy recognition of the recorded sounds."

It will be observed from the above quotation that this is the precise defect in metallic horns which the Nielsen invention undertakes to cure. The Frenchman noted the existence of the defect. Now let us see what he proposes as a cure for the defect. He says that he has tried different plans, and after his experimentation finds "that wood suitably worked and "selected can remedy the defectiveness of the present "phonographs and render these instruments perfect." In other words, he proposed to abolish the use of metal horns and adopt in place thereof wooden horns, and he says in this connection that wood gives vibrations so natural that it accords with all musical instruments as well as the human voice, and permits the same to be recorded and to be reproduced with a softness, a clearness and extreme fidelity and the most delicate shades. Accordingly he proposes a variety of forms of wooden horns. The first consists of horns turned in wood, that is to say, a horn made from a solid piece of wood put into a lathe and turned into the form of a horn. His second form consists of a single piece of thin wood immersed in boiling water or in a steam oven to make it pliable, and then bent around a form of the shape of a cone, after which

other sheets are placed over the same one, thus producing a laminated horn, gluing together the edges. His third horn is made of strips of wood glued together along the edges into a polygonal form, these strips being attached to interior posts or ribs as supports. Instead of wooden posts for the purpose above stated, he states that metallic ones may be used to receive and maintain the sheets of wood. In Figures 14, 15 and 16 (Record, page 381), he shows what he calls "a truncated bell-shaped horn, with metallic bracing." In this horn a folded ring constitutes the outer end, and the strips of wood are inserted into the same, and there held by glue. The strips of wood are disposed as theretofore described, that is to say, by gluing their edges together. In order to get the strips of wood in the proper shape they have been first boiled or steamed and then bent, and in order to maintain the curvature a metallic ring encircles the horn near the middle thereof like the hoops of a barrel, and is connected by rods to the mouthpiece.

The fourth form of horn described is made of strips of different kinds of wood, to which may be added one or two strips of metal and also glass. In this behalf the specification says at page 390 of the record:

"In order to obtain a concordance of sound by synchronism and isochronism, one may advantageously construct the horns of strips of wood of different kinds and also add thereto one or two

strips of metal and also of glass, so that when one records an orchestral piece, all the instruments find their harmonics and that the horn can vibrate in unison. If, for example, the horn is a duodecagonal pyramid, that is with 12 strips, one may put in opposition two strips of rosewood, two strips of metal which may be composed of bands of different metals, two strips of glass, two strips of tulip, two strips of red mahogany, two strips of walnut. One obtains thus an ideal orchestral horn."

The idea conveyed by the above is quite apparent. The inventor considered that different woods and materials produced different vibrations corresponding to the harmonics of the different pieces of the orchestra. Each instrument requires its own particular kind of wood in order to be most responsive, and it seems that according to this inventor there are some instruments which best respond to metal and others to glass. Consequently, in his composite horn he proposed to insert two strips of glass and also two strips of metal. The two strips of metal, he says, were different metals; for instance, one might be brass and the other tin. These two strips of metal were not adjacent to each other but were placed "in opposition," that is, on opposite sides of the horn.

No direction is given as to how the strips of metal are to be attached to the adjoining strips of wood. In regard to the joining of the strips of wood in these horns, the inventor has stated that they were glued together along their edges. When he suggests the

insertion of metal strips among the wooden strips, he does not disclose how the edges of the metal are joined to the edges of the wood. The same remark applies to the glass strips. But, however they were intended to be joined, the patent does not show any ribs. Further along in his specification, beginning at page 390 of the record, the patentee says:

“One obtains thus an ideal orchestral horn.

“For the voice and the song, the violin, the instruments of wood, it is necessary not only to employ wood, but to vary the kinds, which the polygonal form of my horns permits. One understands, indeed, that all the woods do not vibrate equally. Thus the walnut and the beech render very well the grave sounds; the tulip and the white woods, the medium, and the mahogany and the rosewood the high notes. These different woods keep up among them and reinforce the sounds in vibrating in unison with their harmonics like the strings of a piano or of a harp.”

We thus see that the imaginative Frenchman proposes to cure the evils of the metal horns by constructing a composite horn of various kinds of expensive wood and interposing among them on opposite sides of the horn two strips of metal of different kinds, to the end that each instrument of the orchestra would find its response in the particular strip best adapted thereto. In other words, each instrument in the orchestra would, with almost human intelligence, select the particular strip or panel of the horn most

suitable to it and disregard all the other strips. The violin sound, for instance, would religiously avoid the two metal strips and expend all its energy on the wood, because the patentee says a violin sound cannot be reproduced by a metal horn. And so each particular instrument would avoid the "bad" strips and utilize only the "good" ones. A most remarkably intelligent collection of instruments this would be!

The relevancy of this patent is supposed to reside in the fact that the inventor suggested the use of two metal strips intermingled with the wooden strips, and it is urged that that "suggestion" is sufficient to invalidate the Nielsen patent for want of invention. We think the conclusion farfetched and a resort to insubstantial and metaphysical distinctions which find no place in the law of patent construction. In construing patents, courts do not deal in metaphysics or fine-spun theories or nice distinctions. They are not astute to avoid patents. They deal with conditions, not theories. They look at facts, not fancies; at the actual, not the theoretical, state of affairs. They inquire primarily whether or not a patentee has produced some new and useful device, something which has made a step in advance of the prior art and contributed to the wants of mankind. When these questions are answered in favor of the patented device and it is shown that the patentee was the first to produce the same, it is idle to claim that mere suggestions vaguely made in a foreign publication without detailed description of

manufacture, are sufficient to invalidate his invention. The real test is to ascertain whether or not the patented device has added anything to human knowledge, and thereby helped mankind (*O'Rourke vs. McMullin*, 160 Fed., 938), and when tested by this rule, Nielsen's patent cannot be successfully attacked.

It may furthermore be said in respect of this French patent to Turpin that it is merely a vague, indefinite suggestion in regard to the use of two metal strips in an assemblage of wooden strips forming a horn, without any sufficient disclosure as to the process of manufacture; also that it fails to show the presence of the ribs constituting one of the elements of Nielsen's invention; also that it is a mere paper patent which has never gone into use, and constitutes one of those laughable vagaries found scattered throughout the phonographic art, just as we find similar instances scattered throughout every art. Untested suggestions and surmises are not anticipations. (*Asbestos Co. vs. Johns*, 184 Fed., 620.) On the final hearing we propose to show that Turpin's composite horn not only never went into use anywhere but was wholly impractical for any useful purpose whatever. We did not go into that matter in our answer to the same on motion for preliminary injunction because it was not necessary. This is not a final hearing and is not the time or place for producing our evidence in answer to the Turpin patent. It is sufficient on this motion for the Court to see from an inspection of the

Turpin patent that it is not of such conclusive and convincing character that it would have produced a different result if it had been put in evidence in the Sherman Clay & Company case. Just consider for a moment what would have been the result if it had been put in evidence in that case. Is it conceivable that the jury would have found that it was an anticipation of Nielsen, or invalidated his patent for want of invention? We undertake to say that if the patent had been put in evidence at that trial the result would not have been changed.

And furthermore, his Honor Judge Van Fleet considered this Turpin patent on this motion for a provisional injunction and after such consideration concluded that it was not sufficient to avoid the injunction. In other words, he held that it was not of such a conclusive character as to justify a different result from that rendered in the Sherman Clay & Co. case. His Honor, Judge Van Fleet, had ample opportunity to consider the matter. He was thoroughly familiar with what had gone before. There had been three separate, distinct and exhaustive hearings before him up to that time, and the hearing in the case at bar constituted the fourth exhaustive hearing before him. The matter was not slurred over, but was carefully considered. The learned patent lawyer from New York argued most exhaustively and pointed out his views most clearly, after which Judge Van Fleet considered the matter and granted an injunction. How can it be

said that he abused his discretion in so doing! On the face of the French patent he did not find sufficient evidence to justify him in denying the writ, and he postponed further consideration thereof until the final hearing. That final hearing will be had at the next term of the District Court, which begins on November 3rd, 1913. The complainant's depositions have been taken at great length in the East and the case is ready for hearing, so that it is highly probable that such final hearing will be had before this court can have an opportunity to render a decision on this appeal. This fact can be properly considered by this court in its effort to ascertain whether there was an abuse of discretion in granting the injunction.

In connection with this French patent and all the other patents and publications which were put in evidence on the hearing of the motion, we express the opinion that they have tended to strengthen the Nielsen patent and we consider ourselves under obligations to the learned counsel in thus aiding us in the fight for right and justice which we are making. Those prior patents put in by him show that a well-known defect existed in the prior metal horns which Nielsen undertook to obviate; also that these various prior patentees had undertaken to cure that defect by various and sundry means; that none of them succeeded; that Nielsen did succeed and produced a metal horn which cured the long-standing defect; that thereupon the old style of metal horns were discarded by the

entire trade, and the Nielsen invention was adopted universally and continued thenceforth to be the standard used horn for phonographs until many years thereafter, in fact, until the cabinet machines were used, which are known as the hornless machines. These facts justified the lower court in granting a preliminary injunction and show that there was no abuse of discretion.

THE AFFIDAVITS OF APPELLANT.

We do not propose to consider these affidavits in detail. They are many in number and were made by infringers in the Eastern States, which fact alone should be given due consideration. We will, however, venture to say a few words on the subject.

The first affidavit is by Ellsworth A. Hawthorne, an old-time infringer. He produces at page 72 of the record a photograph of a fluted horn, experimented with but never used in the early days. A most casual inspection thereof is sufficient to show that it is of no moment.

At page 73 he produced a catalogue of glass horns, that is to say, horns spun from molten glass in the shape of an ordinary trumpet. Clearly they have no relevancy.

At page 74 he produces a trade catalogue of his company showing the picture of a B. & G. horn and underneath it that of a Nielsen horn. This advertisement, however, was issued in the Talking Machine

World on January 15, 1905, after the date of the Nielsen patent (Record, 69), which merely goes to show that this infringer had even at that early date begun to purloin the Nielsen invention.

The next affidavit is that of John H. George, an employee of Hawthorne, which merely corroborates the affidavit of Hawthorne. Inasmuch as there is nothing in the affidavit of Hawthorne of any materiality, corroboration by George amounts to nothing.

The third affidavit is by Frank H. Stewart, another infringer, who resides in Philadelphia and was a former employee of Hawthorne's firm. He says that at the time of the Spanish-American war, 1898, Hawthorne and Sheble made two large megaphones for the United States battleships Iowa and Oregon, being fourteen feet in length, built up of five or six tapering strips joined together by a lock seam. Neither the megaphone nor any drawing thereof was produced. The device is not material to any issue here, being merely a conical-shaped megaphone. The remaining portions of Stewart's affidavit are as immaterial as that stated.

The next witness was John Kaiser, who invented a paper horn for phonographs and took out a trade mark therefor shown at page 100 of the record. The outward shape is somewhat similar to the Nielsen horn, but that is the only similarity. Kaiser says it was made of separate strips of card board or paper and that the strips were glued together and no ribs

were used. It is another one of those experiments made by inventors for the purpose of obviating the vibrations of metal horns. It made no impression on the art. The affiant also refers to a similar horn made by E. A. Schoettel, called the "Mega" horn, and annexes to his affidavit at page 103 of the record, a copy of Schoettel's advertisement of the "Mega" horn, which he says appeared in a certain paper of March 15, ¹⁹⁰⁵~~1895~~, long after the date of Nielsen's patent (Rec., 90). Upon referring to this advertisement, we find a picture of the paper horn aforesaid, and alongside of it a picture of what appears to be the Nielsen horn, styled in the advertisement "Mega Flower Horn," and shows that even then at that early date Nielsen's rights were being invaded. On page 92 of the record the affidavit refers to the French patent to Turpin, heretofore discussed, and says in reference thereto that he sees no difference between the metal horn of the Nielsen patent in suit and the wooden horn of the French patent. "None are so blind as those who will not see." A witness, who states that he can see no difference between a Turpin horn made of different kinds of wood with the two strips of glass and two strips of metal inserted among them and no ribs, and in a Nielsen horn made of strips of metal with outside ribs and the other characteristics shown, is certainly not worthy of much credence. The said affiant also produced, at page 105, a photograph of what he called a Eureka horn, made out of strips of wood, which he

says he purchased about the year 1907. What relevancy to the Nielsen patent could be found in a wooden horn made two years after the issuance of the patent passes our comprehension.

The next affidavit is by Walter H. Miller, another infringer, employed by the Edison Company. He undertakes to discuss the prior patents and gives an opinion regarding the same. In other words, he offers himself as a patent expert. Those opinions may probably be considered on the final hearing, but upon this motion for preliminary injunction they do not appear to us to be appropriate. He annexes to his affidavit, at pages 124-5 of the record, photographs of what he calls an announcing horn used in the laboratory of Mr. Edison prior to Nielsen's invention, which is nothing more than the old form of B. & G. horn.

One other employee of the infringing Edison corporation tells of the last described announcing horn or megaphone.

The next affiant, Camillus A. Senne, in his affidavit shows that in the early days he was infringing upon the Nielsen patent, and that the owner of said patent brought suit against him for an injunction, and that he allowed the suit to go by default and a preliminary injunction was issued against him. Thereafter he proceeded to make and sell paper horns, and at page 138 is found a photograph of his paper horn reinforced with metal stay strips on the outside. On page

139 is another form of his paper horn reinforced on the outside by gummed tape strips, and at page 140 *et seq.*, of the record, is a patent secured by him in 1906, two years after the Neilsen patent, covering the aforesaid horns. This affidavit tends to strengthen our case. It shows that Senne was infringing on the Nielsen patent and an injunction was taken against him prohibiting further infringement, and thereupon he ceased selling the Nielsen horns and proceeded to sell paper horns. But even those paper horns were soon discontinued.

The next witness is Mr. Louis Hicks, the learned counsel of appellant. He tells us that he has examined the record of the above-mentioned infringement suit against Senne and undertakes to inform the Court as to the contents thereof. We are exceedingly obliged to him for having done this, for as we have above remarked, the matter tends to strengthen our case. The learned counsel next tells us that he has had in his possession since March, 1902, a book entitled "A Complete Manual of the Edison Phonograph," by George E. Tewkesbury, published in New Jersey in 1897, and he annexes to his affidavit a photograph of page 70 of the book showing the large number of horns and the various styles of horns experimented with by Mr. Edison before he adopted the Nielsen horn. We cannot too strongly express our sincere gratitude to the learned counsel for having furnished us with this piece of valuable information. We had

never heard of Mr. Tewksbury or his book up to this time, and probably we never would have heard of him, or known of the valuable evidence his book contains on our behalf except for its production on the hearing of this motion by the learned counsel for appellant. If we had known of the existence of this book, we surely would have put it in evidence on this motion as the strongest possible proof that could be offered of the validity of the Nielsen patent. At page 70 of the said book is found a cut, and on page 162 of the record is a reproduction of the same showing the vast number and different styles, shapes, and forms of horns which had been experimented with and tried by Mr. Edison, the founder of the phonograph art, before he adopted the Nielsen horn. We have not counted the horns shown, but are informed, and we believe one of the affidavits states, that Mr. Edison had experimented with over two hundred different forms of horns before obtaining what suited him. This picture shows numerous different forms, and among them we find some wrapped around with tape, which was one of the expedients adopted in an effort to minimize the vibrations of the metal. This statement does not appear in the record, but it is a fact in the art which will appear at final hearing.

Now let us quote from Mr. Tewksbury's book what he says regarding this picture. It will be found on pages 152-154 and reads as follows:

"With the phonograph a speaking tube and listening-tube are provided. The speaking tube for dictation purposes meets the conditions acceptably. The single tube for listening is the best device for the purpose. But for concert use and public entertainment, the sound must be thrown out so that many persons can hear it, and for this purpose numerous types of amplifying horns have been produced. It would astonish the casual reader to learn of the number and thoroughness of the experiments in that direction. Mr. Edison has himself tried a vast number of sizes and shapes, out of all sorts of material. Other experimentalists and enthusiasts have gone over the same ground, and branched out into new paths. Yet all have come back to the main traveled road. Wood, iron, steel, zinc, copper, brass, tin, aluminum, cornet metal, german silver, have been tried. Glass, too, and hard rubber, papier-machè, and probably every other product that nature yields or man contrives. The latitude as to form and shape being greater than the resource in material, there have been almost innumerable attempts in that line. After all of which it may be said that tin and brass, defective as they are, have been settled upon as the most available, and the forms now known in the trade as the most desirable. Any horn to be good must come out of sound metal, and be perfectly joined. Ordinary joining will not do, and imperfect metal is a delusion. . . .

"The 26-inch standard tin horn is deservedly the amplifying device most used, and all things considered, gives as good results as any. It is not expensive, can be used for recording and reproducing both, and fulfills all reasonable requirements of horn service. When correctly made, block tin is used, and the joints are so fastened as to prevent rattle. If made of cheap material, it

is the same abomination that all other cheap supplies for the phonograph are. The horn is heavily japanned, not for looks merely. It is held in place on a folding tripod, to the loop of which it should be attached by string, ribbon, or other non-conducting material, never by a metal hook or wire. The connection with the speaker of the phonograph is effected by a short length of rubber tubing. In the use of this, as with all other large horns, the best results are obtained many feet away from the mouth of the horn, which is so built as to project the volume of tone forward. The measurement at the bell or opening of this horn is 12 inches, and the lines from the bell to the nipple are straight. Similar in results, but different in character, is the 22-inch brass horn preferred by some because it is thought to give a more ringing effect to the reproduction of band and orchestra music, and claimed by others to make all reproduction brighter. This horn has a flaring bell, and is 12 inches in width at its mouth. It is suspended the same as the 26-inch horn to the loop of a folding stand, and makes a striking appearance. . . .

"The interesting picture facing this chapter shows a group of recording horns used in a record laboratory. It was drawn from a photograph."

The 26-inch standard tin horn referred to in the quotation is our old friend the B. & G. horn. It will be seen that the author considers it the best horn produced up to that time (1897), although it contained certain known defects. Up to that time no one had been able to cure the defect in the metal horn. Nielsen did cure the defect and as proof of that we have merely to refer to the fact that the old horns were

thrown out of existence and the Nielsen horn took their place.

Now let us see what Mr. Edison had to say on the subject after the Nielsen horn was made known. We introduced three advertisements of Mr. Edison's company, the National Phonograph Co., inserted in the "Talking Machine World" on December 15, 1907, January 15, 1908, February 15, 1908, and March 15, 1908, respectively, after Mr. Edison had adopted the Nielsen horn.

The first of these advertisements (Complainant's Exhibit No. 1.) contains a cut of a Nielsen horn and uses the following language:

"MORE ATTRACTIVE THAN EVER.

"The new Horn and Crane of the EDISON PHONOGRAPH affords just the needed touch.

"The one thing which the Edison Phonograph needed to make it complete has been added—a large, handsome, prettily shaped horn, supported by a nickel-plated swinging crane.

"Each model has now been so equipped, and in each case the proper size and shape of horn is furnished to produce the best possible results.

"This new equipment means much to Edison dealers. It means that the carrying of a stock of horns is no longer necessary; that the sale of an Edison Phonograph includes the sale of a horn and a protected profit to the dealer on both.

"The cutting of prices on horns has always worked a hardship to those dealers who maintain prices. This is now eliminated, as all dealers must

sell the Edison Phonograph, *complete with horn*, at the full price.

"The new complete Edisons are more attractive than ever, and the fact that each model now includes everything necessary to perfect work, with no extras to buy, is sure to appeal to possible purchasers. The slight advance in price on account of the new improvements is really not a higher price, for purchasers have always paid an extra price for a horn out of the dealer's stock. The dealer now sells a horn when he sells the Phonograph, gets full price and makes a liberal profit on it.

"If you do not handle Edison Phonographs, this new feature is an added reason why you should. Write for new catalogue and full particulars; also for the name of a nearby jobber who can supply you with Edison goods."

The second advertisement (Complainant's Exhibit No. 2.) contains a cut of a Nielsen horn and uses the following language:

"WHEN YOU SELL AN EDISON PHONOGRAPH YOU
SELL A COMPLETE INSTRUMENT.

"Heretofore the sale of talking machines and the sale of horns have been two distinct transactions. This was because no talking machine had a satisfactory horn.

"Now the Edison Phonograph has its own horn and swinging support. The horn is large, handsomely shaped and exactly adjusted to the instrument's needs. It sets the Phonograph off, attracts interest and best of all, it pleases purchasers every time.

"The horn business has always been a drawback to the trade. It led to price-cutting which affected

profits, necessitated carrying a large stock of horns and complicated selling methods generally.

"Now the customer gets *the best and most suitable horn to be had* as a part of the Phonograph, pays the price for both in one transaction, and the dealer makes a good profit on both. This *new equipment* is making new records for dealers in Phonograph sales. Are you getting the benefit? If not, write us for full information and the name of a nearby jobber who can supply you with whatever you need."

The third advertisement (Complainant's Exhibit No. 3.) contains a cut of a Nielsen horn and uses the following language:

"THE NEW HORN OF THE EDISON PHONOGRAPH
MEETS A LONG FELT WANT.

"This new horn is big, shapely and handsome. It sets the instrument off and gives to the reproduced sounds a clearness and sweetness not possible with other horns.

"The appeal it makes to the consumer is instantaneous. It looks the money and it gives the results.

"The horn is sold with the Phonograph as a part of it—one price for both. One set of motions and the whole transaction is completed.

"The horn brings the dealer a good profit. The price is fixed, just as the price of the Phonograph is fixed. No competitor can influence a sale by cutting the price on the horn, and as the Edison horn is made for the purpose of securing the best results from the Phonograph, no stock of horns is necessary.

"The *new equipment* of the Edison puts the Phonograph selling proposition on the right basis. *It means easier and quicker sales, full profits every time, no unfair competition and no accessory stock.*

"If you are not an Edison dealer, you are overlooking a big money-making opportunity.

"Write to-day for full information and the name of a nearby jobber who can give your order immediate attention."

The fourth advertisement (Complainant's Exhibit No. 4.) contains a cut of a Nielsen horn and uses the following language:

"THE FASTER YOU TURN OVER YOUR CAPITAL THE
MORE MONEY YOU MAKE.

"There is nothing so useful in business as ready money. A stock of musical instruments represents capital, but so long as it is stock it isn't paying running expenses or declaring dividends. Money invested in a stock of

EDISON PHONOGRAPHS

comes back over your counter in a steady stream, bringing profits of good proportions. The turn-over is so quick that a small amount of capital will take care of this end of your business. *The new horn* and crane of the improved Edisons makes it unnecessary for you to carry horns in stock, and the great and growing demand for this wonderful entertainer makes it almost imperative that you add Edison Phonographs to your lines. You can get full information and whatever instruments you wish from a nearby jobber whose name we will be pleased to furnish you on request. Write us to-day about it."

The fifth advertisement (Complainant's Exhibit No. 5.) contains a cut of a Nielsen horn and uses the following language:

"Did you ever figure up your profits on talking Machine Horns and find there were none? Most dealers have, and that has been the trouble. A stock of horns that ties up money; a reduction in price to influence a talking machine sale; a cut to meet the price of some other dealer, and where is the profit?

"It is because this situation exists in nine out of ten talking machine stores that the

NEW EDISON PHONOGRAPH

with its big, appropriate, properly proportioned horn, has received such a welcome from the trade. The horn goes with the Phonograph. The price includes both. There is a good profit in each. The new horn puts the Phonograph at its best, satisfies every purchaser, makes a stock of horns unnecessary and makes price-cutting impossible. Are you selling the new Edison? Are you pushing it? If not the most profitable part of the talking machine business is going to your competitors. Write us or a nearby jobber for catalogue of new models, terms, etc."

It will thus be seen that soon after Nielsen's invention was made known to the public, Mr. Edison adopted it and called it a perfect horn. He discontinued the use of the prior horns because they were defective and did not produce good results. He adopted the Nielsen horn because it cured those defects and produced a perfect result. Not only did he adopt the Nielsen horn, but he pronounced it a

perfect horn, and has continued to use it up to the present time. He says that no prior horn was satisfactory, that this "new horn" makes his phonograph "complete," also that it secures "the best results from the phonograph," that it reproduces sounds with "a clearness and sweetness not possible with other horns," that it "affords just the needed touch," and "meets a long felt want."

Here, then, we find a piece of evidence as to the validity of the Nielsen patent which could not possibly be made stronger. Mr. Edison was the inventor of the phonograph and the founder of the phonographic art. He is the wizard to whom we all defer in electrical matters. The evidence shows that he, after experimenting with over 200 different forms of horns, could get nothing better than the old B. & G. horn, in which was the defect which Nielsen cured, and that when the Nielsen horn was brought out he recognized its excellence at once and adopted and used it to the present date, having discarded his own horns. This surely is the highest tribute of praise that could be given to the Nielsen invention, and is alone and of itself sufficient to justify any court in granting a preliminary injunction against Mr. Edison's company and the distributors of his horns. And yet we are gravely told by the counsel for appellant, who furnished us with this invaluable evidence, that it was an abuse of discretion by the lower court to

have given it the force and effect to which it was entitled.

REPLY TO APPELLANT'S BRIEF.

At this point we have received a copy of appellant's brief, and if time permitted, we would answer it in detail. But time does not permit. We have only a short time left for printing and filing our brief within the time prescribed by the rules. Our printer is standing over us calling for "copy," and we must heed his demand in order to be on time. Consequently, we can answer appellant's brief only in the most general terms and without going into elaborate detail.

The first thing to strike one on reading it is that it treats this case as an appeal from a final hearing on the merits instead of an appeal from an order granting a preliminary injunction. Counsel argues that the patent is invalid for want of invention, anticipation, prior use, etc., etc., and even goes so far as to insist that upon this hearing the court should enter an order for the final dismissal of the case just as though a final hearing had been had on the merits. Even at the expense of being tedious, we again remind counsel that this is an appeal from an order granting a preliminary injunction and that the examination of this court is limited to inquiring whether or not the lower court abused its discretion in granting the preliminary injunction, whereby the court merely under-

took to hold matters *in statu quo* until a final hearing could be had. In this connection we refer the court to our brief in the Sherman & Clay Co. case, No. 2307, where this point is considered.

On page 2 the counsel complains that Judge Van Fleet rendered no written opinion and decided this matter from the Bench, stating that the learned Judge did not read the patents or affidavits nor look at the defendant's brief. Judge Van Fleet did not need to render a written opinion because he had already considered this patent on three separate occasions and was fully posted regarding the same, and if it be a fact that he did not read the prior patents or affidavits presented by counsel, nevertheless he carefully listened to a statement of their contents and explanations thereof by the learned counsel for appellant. Furthermore, the counsel was allowed all the time that he desired for presentation of his case. He was not restricted in any particular whatever. He explained all his prior patents and the affidavits of his infringing witnesses, and fully and elaborately stated and argued all the issues involved. No obstacle was placed in the way of a full presentation of the case. The rules of the lower court were suspended so as to allow the hearing of this motion on a non-motion day, a special day being set aside for the hearing, and the learned counsel talked and talked and talked to his heart's content. Thereupon the court decided the case from the Bench, apparently being of the opinion that the matter pre-

sented was so easy of solution that it did not require a submission or the preparation of a written opinion.

On page 5 of his brief the learned counsel asserts that upon the hearing plaintiff made no proof of title to the patent in suit, and, consequently the motion should have been denied. This is nothing short of trifling with the court. The bill of complaint, which was under oath, alleged title in plaintiff. The answer merely sets out that the defendant does not know and is not informed on that matter. By stipulation the record in the case of Sherman Clay & Co. is made a part of the record herein, and the said Sherman Clay & Co. case record shows title to the patent. In fact it contains certified copies of all the assignments constituting plaintiff's title. Those assignments are on file with the clerk of this court, having been brought up as exhibits in the Sherman Clay & Co. case. Furthermore, the Judgment Roll in the Sherman Clay & Co. case, which is before the court, is in effect an adjudication of title sufficient on a motion for preliminary injunction against another infringer. In view of all this we again assert that in our opinion it is trifling with this court to assert that no title to the patent has been shown.

On pages 10, 11 et seq., counsel proceeds to give dictionary definitions of the words "plurality," "plural," "taper" and "tapered," and proceeds to construe the patent by virtue of such dictionary definitions. He says "plural" means more than one, that is to

say, two, and consequently a Nielsen horn can be made of two pieces, from which he argues that the two-piece horns of the prior art are anticipations. Also that the word "taper" means regularly narrowed to a point, and therefore the old horns of conical or pyramidal form, or any other form, which regularly narrow towards a point, are anticipations. He also brings up the stale argument, so often urged and as often disposed of, that Nielsen's patent is limited to the right-angled flanged seam. All these various matters referred to were disposed of in the Sherman Clay & Co. cases. The ruling thereon has become the law of the Northern District of California until it shall be reversed by this court. This is no new matter. It is the oldest of old matters, and it is binding on other infringers upon a motion for preliminary injunction until it shall be overruled by some competent authority. It would, therefore, be a waste of time for us to argue those matters on this hearing, even though we had the time at our disposal, which we have not.

But in any event it is improper to rely solely on dictionary definitions in construing claims. As said by the Court of Appeals of the seventh circuit, in *London Co. vs. Stickler*, 195 Fed., 755:

"Elements in claims should be read with reference both to the structure and the function given in the description of the invention. Dictionary definitions should not be applied to words in claims if the patentee in and by his drawings and descrip-

tions of parts and functions has clearly supplied his own dictionary."

Along the same lines is this language of the Circuit Court of Appeals for the third circuit, in *Washer vs. Cramer*, 169 Fed., 629, viz:

"The combination or description of the standard washer, or of this Wearne tub, can be read, it is contended by defendant's counsel, into the first claim. This may be true, if we stick in the bark, by looking at the language of the claim, dissociated from the specifications; but no invention can be practically or fairly understood or explained, if this dissociation is absolutely adhered to. As we have already shown, the element described in the first claim, as 'means for actuating said lever,' must not be taken to be any means, such as impracticable hand power applied to the lever, but the efficient practical means described in the specification."

Applying this rule of construction we have no difficulty in construing Nielsen's claims. In the specification he says that the horn is *bell-shaped* in form and tapers *outwardly* gradually from the small end to the large end, and then he adds that this "*curve* or taper is greater or more abrupt adjacent to said larger or mouth end." He also says that the strips forming the body portion of his horn are composed of sheet metal, and that it is the construction of the body portion of the horn *as hereinbefore described* that gives thereto the qualities which it is the object of this invention to produce, which objects are the result of

the formation of the horn or the body portion thereof of longitudinal strips b and providing the outer surface thereof with the longitudinal ribs b², and *curving the body portion of the horn in the manner described*. According to this description the word "taper" as used is synonymous with the word "curve," and this curve or taper is said to be *outwardly* and gradually formed but more abrupt adjacent to the larger end, to the end that the horn may be made in bell shape, and it is *the curving of the body portion of the horn in the manner described* that constitutes one of the essential elements of the invention. The essential elements of the invention are stated by Judge Van Fleet in his charge to the jury at pages 272-3 in the Sherman Clay & Co. record.

Beginning at page 12, counsel undertakes to give his construction of the Nielsen patent, deducing therefrom the conclusion that it was anticipated by the prior art. This matter also was determined in the Sherman Clay & Co. case, and is not open at this time. As showing what construction was given to those claims we refer the court to Judge Van Fleet's charge to the jury in the Sherman Clay & Co. case, beginning at page 272 of that record in case No. 2306. The construction there given is the correct construction and it must stand until reversed by some competent authority.

On page 15 of his brief, the counsel makes a long argument regarding the effect of the file-wrapper contents on the Nielsen patent. But this matter is not

new evidence. Said file-wrapper was in evidence in the Sherman Clay & Co. case and constituted the principal defense there made; hence it is old matter in this case and not new matter. We shall not stop to discuss it, but merely refer the court to our discussion thereof in our brief in case No. 2306 against Sherman Clay & Co., beginning at the bottom of page 33 thereof and extending to the bottom of page 39, which we ask to be read as a part of our brief herein, if the court considers it necessary to investigate the question.

Counsel then proceeds at page 21 to argue that the patent is anticipated by the two-strip metal horns stated in the affidavits of the infringing witnesses to have been used in 1897. While these affidavits are new in the sense that they are made by witnesses who did not appear in the other case, nevertheless the fact is that substantially similar horns were in evidence in the other case as prior devices and were held to be no anticipations. Consequently, these affidavits on this point are in no way new matter. But even if they were the court would postpone a decision on that subject matter until the final hearing, at which the witnesses could be cross-examined and subjected to all the usual tests applicable for arriving at the truth of matters *in pais* alleged to have occurred many years ago. The motion for an injunction is not the time or place for determining such matters. Only a final hearing is proper therefor.

Counsel then proceeds to argue that the patent in

suit is anticipated by patents of Turpin, Villy, Gersdorf, Kaiser and McVeety & Ford. We have already discussed the Turpin patent and have not time to dwell further on it. We shall have a great deal to say about it at final hearing, but on this motion for preliminary injunction it is sufficient to observe that it is not of such a conclusive character that it would have changed the result if it had been in the test case. It represents a "freak" horn, a ridiculous and impracticable device, a mere vague and shadowy suggestion emanating from an apparent "crank." The suggestion that in a horn made of different strips of material the various musical sounds from a band of many pieces passing through the horn would select the particular strip of the horn against which to impinge, some of the sounds selecting one strip and some another strip, but no two selecting the same strip, whereby all of the sounds would come out in harmony, is too absurd to merit serious consideration, and yet that is the horn which the learned counsel gravely asserts is a complete anticipation of Nielsen's invention.

The British Villy patent is not new matter, because the corresponding United States patent for the Villy horn was in evidence in the other case. Hence no consideration of it is necessary here.

The Gersdorf patent is for a *funnel* with which to fill barrels, jugs, and bottles with liquid. The learned counsel refers to it as a "horn or funnel." If it gives him any satisfaction to call Gersdorf's funnel a horn,

he may do so; but Gersdorf does not call it a horn, nor would any disinterested person call it a horn. The counsel carries the idea to absurdity, for at page 49 he says that it is self evident that a horn is a funnel and that a funnel is a horn. At page 50 he says that it requires no adaptation of a funnel to use it as a horn for a phonograph; also that Nielsen was not the first to discover that a horn was a funnel or that a funnel was a horn, nor was he the first to discover that a funnel could be used as a horn for a phonograph. This appears to us to be bordering dangerously on the ridiculous. Counsel has evidently been carried away by his zeal. We freely admit that Nielsen never discovered that a horn was a funnel or that a funnel was a horn, nor that a funnel could be used as a horn for a phonograph. We do not think that anyone has ever discovered that fact. It may be that some features of construction in a funnel may be utilized in constructing a phonograph horn, just as other features in the construction of mechanical instruments or other devices may be used. But to argue that a funnel used for filling barrels, jugs, and bottles with liquids is a phonograph horn for the transmission of delicate musical sounds from a music box, and *vice versa*, that such a phonograph horn is nothing more than a funnel for filling barrels, jugs, or bottles with liquid, and, therefore, that the funnel of Gersdorf is an anticipation of the phonograph horn of Nielsen, is indeed a unique bit of logic.

Along the same lines counsel argues at page 62 that the device shown in the McVeety and Ford patents are also an anticipation. Those patents show a ship's ventilator made of metal sections, and following the same line of argument, we presume that counsel will say that a ship's ventilator is nothing more than a phonograph horn and that a phonograph horn is nothing more than a ship's ventilator, and, therefore, the ship ventilator patent anticipates the phonograph horn patent. It is to be noted, however, that this McVeety and Ford patent was in evidence in the Sherman Clay & Co. case and is therefore not new matter herein.

Beginning at page 51, counsel asserts that the Nielsen patent is anticipated by the trade mark of John Kaiser for a Kaiser horn. The trade mark itself appears in the record at page 100. The claim of the trade mark is for the use of the words "Kaiser horn," and all that the trade mark shows is a picture of a horn, and that it is bell-shaped, but without any detailed description. It is idle to assert that the picture of a trade mark, without any description, is an anticipation of a subsequent patent for a mechanical device. Pictures are not anticipations. Hence this trade mark can have no effect other than as showing that at that time Kaiser was in possession of a horn of that shape. On referring to Kaiser's affidavit we find that his horn was composed of strips of paper united together by glue. In other words, with a pair

of scissors or shears he cut out a number of paper strips so that the edges would overlap, and then pasted these edges together with glue, thereby producing a paper horn having a smooth exterior and a smooth interior without any ribs either inside or outside. The only similarity to Nielsen's horn resides in the shape; but as we have repeatedly said, shape is only one of the elements which go to make up Nielsen's combination. He does not undertake to patent the shape in and by itself, but only uses it as an element in combination with the other elements. Indeed all of his elements are old. He merely gathered these elements together and combined them into one harmonious whole. Counsel seeks to anticipate him piecemeal, that is to say, by finding one element in one patent and another element in another. That is the same old story of the infringer, who alleges that it is no invention to gather up separate elements from separate devices and combine them all into one device, saying that anyone skilled in the art could do that. Such reasoning has repeatedly been held to be bad. The invention resided in the mental conception that these elements could all be gathered together into one combination and then actually joining them into such a combination thereby producing a new and useful result. After it has been done it is easy enough to see how it was done. It has been said that prophecy after the event is easy prophecy.

As if realizing that his argument theretofore made

would go for naught, counsel argues at page 68 that Nielsen's construction does not improve the sound producing qualities of the horn. He says that the affidavits of experts in the art show that such a claim is entirely without foundation. This is another favorite position with infringers. After using the patented device and making enormous fortunes out of the same, they come into court and gravely assert that such a device is worthless and without any utility whatever. The so-called "experts in the art" referred to by counsel as having given such opinions are the various infringers in the eastern States, who made the affidavits in question. Is it possible that a court would be influenced by such opinions of infringers, when it appears from the published statements of the great Edison himself that this construction of horn is the last step in the art of horn construction and affords just the needed touch necessary to make his phonograph a perfect instrument?

Beginning on page 35, counsel viciously attacks the charge of Judge Van Fleet to the jury in the Sherman Clay & Co. case, alleging no less than six errors in twelve lines of said charge, beginning at the bottom of page 272 of the Sherman Clay & Co. record. Whether that charge be error or not is for this court to determine on the writ of error in that case. But the construction there given of the patent was not erroneous. The specification of the patent says that the horn is "bell-shaped in form," and it also states

that said horn "tapers outwardly gradually from the part a³ to the larger or mouth end a⁴, and this curve or taper is greater or more abrupt adjacent to said larger or mouth end." The word *taper* is used in the specification as synonymous with *curve*. The expression used is "curve or taper." This curve or taper is stated to be *outwardly*; that is to say, in plan. It does not refer to a taper along the edges of the strips, but refers to a curve or taper in plan outwardly from the small to the large end of the horn, so that a string stretched from the inner end of the horn body to the outer rim will not touch the horn except at the two points. This is a wholly different curve or taper from that shown in the horns of the prior art having a conical shape. In them a string stretched from the inner to the outer rim of the cone will lie flat on the surface at all points. Such a curve or taper is not a curve or taper in plan. These features of the Nielsen horn appear in his specification and are illustrated by his drawings. The claims terminate with the words "Substantially as shown and described." This language permits us to go back to the specification and see what is the showing and description of the various elements and their combination together. Counsel asserts that Judge Van Fleet read into the claims features not there called for. We deny this most emphatically. He read nothing into the claims which was not there by fair inference and proper construction. He pointed out to the jury what were the special

characteristics of the Nielsen invention, telling them that the explanation given was in colloquial language rather than in technical form, but that it represented the invention called for by the claims. The colloquial form of language used was for simplification to the jury. Had the case been before the court alone, technical language might have been used. A translation of this colloquial language into technical form will show that the claims accorded therewith and that Judge Van Fleet read nothing in the claims which was not there by fair inference and reasonable construction.

On page 50, et seq., of the brief, it is urged that Nielsen's horn was nothing more than a case of double use. The law on that subject is stated by counsel to be that where an old device is adopted, without change or with very slight change that would occur to any skilled mechanic, to perform a new use for which it was not intended, then no invention was involved in using the old device for the new use. This is not a case for the application of the doctrine of double use, because Nielsen has not merely used an old device without adaptation or change for a new use. But the law is not correctly stated by the learned counsel. The law of double use is that the new use, to which the old device is applied, must be a use *analogous to the old use* in order to invalidate the patent. If, however, the new use is not analogous to the old use, then the application of the old device to the new use may consti-

tute invention. (*National Tube Co. vs. Aitken*, 163 Fed., 254.) Consequently, the transfer of an old device from one art to another art without change mechanically is frequently held to be invention. Thus the electrical and mechanical arts are not analogous (*General Electric Co. vs. Bullock*, 152 Fed., 427); the saw-mill art is not analogous to the steel-rolling art (*National Tube Co. vs. Aitken*, 163 Fed., 260). But photography and blue-printing are analogous (*Elliott vs. Youngstown*, 181 Fed., 345). Pumps and dredger pipes are likewise analogous (*Lewis vs. Simple*, 177 Fed., 407). Other instances might be cited, but it is not necessary. Consequently, even if it were a fact that Nielsen merely took an old device from the ship ventilator art or the whiskey barrel art or the metal funnel art, and applied it without change to the phonograph horn art, invention might be present.

At page 72 it is asserted that it is no invention to make out of metal something which was before made out of other material. That doctrine has no application to the facts in this case. Nielsen's invention does not consist in making out of metal a thing which had theretofore been made from paper, celluloid, or wood. That is not the gist of his invention. This is too palpable for discussion.

At page 78 it is set up that the plaintiff below was guilty of laches in bringing its suit. This point was disposed of in the Sherman Clay & Co. equity case. The facts are that the National Phonograph Co. did

not commence to sell these horns until 1907, and the defendant herein, Pacific Phonograph Co., was not incorporated nor did it go into business until some years after 1907. We have not time to look up the exact date. It also appears that prior thereto the patent owner had brought one suit and obtained an injunction by default against one infringer; had notified the National Phonograph Co. of its infringement and tried to make settlement; had tried even to sell them the patent; also that the infringement of the National Phonograph Co. and others broke up complainant's business in May, 1908; also that in 1909 the National Phonograph Co. finally notified complainant that it would not make any settlement, and that in the following year, to-wit: April, 1910, complainant secured the services of its present attorney, and as soon as he could investigate the matter thoroughly brought a test case against Sherman Clay & Co., taking care to keep the National Phonograph Co. informed all the time of the pendency of the said case and the steps therein taken and the decision therein made. It further appears that the reason why suits were not brought sooner was that the Searchlight Horn Co. was in financial distress, and unable for this reason to secure the services of competent attorneys. This was all disposed of in the Sherman Clay & Co. case as well as in the case at bar. We refer the court to the record in the Sherman Clay & Co. equity case, where the affidavit of Mr. Locke is found, also to his affidavit in the

present case, also to our brief in the Sherman Clay & Co. equity case where the subject is treated of.

In this connection the counsel complains bitterly of the fact that these suits were brought on the Pacific Coast instead of being brought in the East, where, he says, "knowledge of horns for phonographs exists," thereby implying that no such knowledge exists on the Pacific Coast. We are perfectly willing to give all due credit "to the Wise Men of the East," but at the same time we venture to suggest that all wisdom does not center in the East, and that we of the West do know something regarding phonographs and the law relating thereto. However, when it is pointed out that the suits which were brought on the Pacific Coast were against distributors of the Eastern Talking Machine Companies and were defended by their chosen attorneys, and that evidence was produced from witnesses in the East, the criticism of counsel loses any force that it might otherwise have had. The remarks of counsel in this regard are unworthy of him and a court of last resort is not a proper place for the indulgence in such tactics. But if a statement of any reason for bringing the suit on the Pacific Coast instead of in the East were necessary, it would be sufficient to point out the fact that the attorneys, whom the complainant happened to employ, reside on the Pacific Coast. The infringements are scattered all over the United States, and surely a complainant has a right to select his own

battle ground. If the suit had been brought in the East, we would have been compelled personally to go there at great expense to try the case. As it is, the learned counsel of the Edison Co. has been compelled to come West to try the case. Can it be attributed to us as a cause of reproach that we are trying to save our client as much cost and expense as possible?

The last point made is that it does not appear but that the infringing horns were obtained from the Standard Metal Manufacturing Co., a licensee of appellee. The answer to this is that the Standard Metal Manufacturing Co. never was a licensee of the appellee for the sale of the Nielsen patented horns. The only connection between the two companies was that in May, 1908, the appellee turned over to said last named company its business of making and selling folding horns, which had theretofore been made by the appellee under a patent to one Berner. There never was any license given under the Nielsen patent, and the Standard Metal Manufacturing Co. never made any horns under said Nielsen patent and paid royalty therefor. These facts appear from the testimony in the Sherman Clay & Co. case, where it is distinctly stated by Mr. Locke that the arrangement referred to the folding horn. Furthermore, whatever that arrangement was, it was only a temporary one and has long since expired by limitation. And still further, all of the horns of the Edison Co. were not ob-

tained from the Standard Metal Manufacturing Co., but some of them were obtained from other sources, notably from the Tea Tray Company. And finally, the object of this injunction was to prevent further infringements of the patent. The defendant was not only selling infringing horns, but was threatening to sell more of them and to continue the sale thereof, and it was for the purpose of preventing this threatened infringement that the injunction was sought. Nor is there any such defense set up in the answer.

In connection with this brief we ask the court to read and consider our briefs in cases 2306 and 2307 against Sherman Clay & Co. which are on file herein.

In conclusion we reiterate that the next term calendar of the District Court is by law to be called on November 3, 1913, the day on which this appeal is to be argued. At the calling of that calendar this case will be set for trial. The depositions have been taken in the east, and the case will be tried on the day set for the trial. Consequently the final hearing will probably be had and the case be disposed of on the merits by the lower court before this court will have opportunity to dispose of this appeal. In such event this appeal will become a moot case. The appellant has secured a stay of the injunction and has not been under actual restraint a single day, hour or minute. The appellant has secured all the benefit it could have

secured if the injunction had been denied. We ask that the order appealed from be affirmed.

Respectfully submitted.

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